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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/870,962	05/30/2001	Olga Bandman	PF-0614-2 DIV	5425

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EXAMINER

MONSHIPOURI, MARYAM

ART UNIT	PAPER NUMBER
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1652

DATE MAILED: 09/12/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/870,962

Applicant(s)
Bandman et al.

Examiner
Maryam Monshipouri

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on _____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 and 54-62 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claims 1-15 and 54-62 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

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Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-2, drawn to isolated protein kinase homologs PKH1-9, classified in class 435, subclass 194.
- II. Claims 3-7, 9, 11-12, 54-62, drawn to isolated polynucleotides encoding said enzymes, vectors and host cell comprising said polynucleotides, methods of expressing said polynucleotides, classified in class 435, subclass 194.
- III. Claim 8, drawn to transgenic organisms comprising said polynucleotides, classified in class 800, subclass 8.
- IV. Claims 10, drawn to isolated antibodies which specifically bind said kinases, classified in class 350, subclass 387.1.
- V. Claims 13-14, drawn to methods of use of said polynucleotides in a hybridization assay, classified in class 435, subclass 6.
- VI. Claim 15, drawn to methods of amplifying target polynucleotides, classified in class 435, subclass 6.

For each inventions I-VI above, restriction to one of the following is also required under USC 121. Therefore, election is required for one of the inventions I-VI and one of the invention (A)-(I).

- (A). SEQ ID NO:1, or a DNA sequence encoding it.
- (B) SEQ ID NO:2, or a DNA sequence encoding it.
- (C) SEQ ID NO:3, or a DNA sequence encoding it.

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- (D) SEQ ID NO:4, or a sequence encoding it.
- (E) SEQ ID NO:5 or a DNA sequence encoding it.
- (F) SEQ ID NO:6 or a DNA sequence encoding it.
- (G) SEQ ID NO:7 or a DNA sequence encoding it.
- (H) SEQ ID NO:8 or a DNA sequence encoding it.
- (I) SEQ ID NO:9 or a DNA sequence encoding it.

The inventions are distinct, each from the other because of the following reasons:

The inventions of Group I-IV are patentably distinct each from the other because each is directed to a product of unrelated structure and function.

The polypeptides of Group I, the antibodies of Group IV, and the transgenic organisms of Group III are each unrelated to any of the methods of Groups V or VI because said products are neither made nor used by said methods.

Inventions II and V (or VI) are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the DNA of Group II may be used for recombinant expression of said kinases which is a totally different method than any of those of Groups V or VI .

The method of Groups V and VI are patentably distinct because each method has different steps and different end-points.

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Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Maryam Monshipouri, Ph.D. whose telephone number is (703) 308-1083.

The Examiner can normally be reached daily from 8:30 A.M. to 5:00 P.M. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Dr. P. Achutamurthy, can be reached at (703) 308-3804. The OFFICIAL fax number for Technology Center 1600 is (703) 308-4242.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 1600 receptionist whose telephone number is (703) 308-0196.

M. Monshipouri
Maryam Monshipouri, Ph.D.

Patent Examiner